UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 December 2008</u>.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-36</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-36</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1- 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-12 and 33 recite a "system". The use of the word "system" does not inherently mean that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. All may be reasonably implemented as software routines and thus drawn to a system of software. Software does not fall into one of the statutory categories of invention.

Claims 13-32 and 34 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-14 and 16-36 as best understood are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. PGPUB 2002/0095454 to Reed.

As concerns claim 1, a communication system comprising: a database (0090-database 11;

32) adapted to store communication tag information of a task tag; and a database agent

(0031;0090) adapted to determine if a communication has the task tag, wherein the database

agent is adapted to transfer predetermined communication tag information of the task tag of the

communication to the database, and wherein the database agent is adapted to automatically send

a communication based upon information stored in the predetermined communication tag

information (abstract;0090).

As concerns claim 2, a communication system as in claim 1 wherein the communication

comprises an email (0090) and the database agent adapted to determine if the email has a task

tag.

As concerns claim 3, communication system as in claim 1 wherein the task tag comprises

a task topic and a task reminder (0180), and wherein the database agent is adapted to transfer

the task reminder to the database.

As concerns claim 4, a communication system as in claim 3 wherein the database agent (0031;0090) is adapted to transfer the task topic to the database with the task reminder.

As concerns claim 5, a communication system as in claim 3 wherein the database agent (0031;0090) is adapted to store the task reminder in the database corresponding to a task topic already stored in the database.

As concerns claim 6, a communication system as in claim 1 wherein the database agent (0031;0090) is adapted to generate a report based upon communication tag information stored in the database.

As concerns claim 7, a communication system as in claim 6 wherein the database agent (0031;0090) is adapted to automatically generate the report based upon a predetermined event.

As concerns claim 8, a communication system as in claim 6 wherein the database agent (0031;0090) is adapted to generate the report based upon a request submitted by a user.

As concerns claim 9, a communication system as in claim 1 wherein the communication tag information comprises an importance factor (0294,0318-preference,0322), and wherein the database agent is adapted to prioritize at least a portion of the communication tag information based upon the importance of factors of the communication tag information stored in the database.

As concerns claim 10, a communication system as in claim 1 wherein the database agent (0031;0090) is adapted to automatically obtain information relating to the communication tag information from a remote computer.

As concerns claim 11, a communication system as in claim 1 wherein the database agent

(0031;0090) is adapted to collate at least a portion of the communication tag information stored

in the database.

As concerns claim 12, a communication system as in claim 1 wherein the communication

tag information comprises a deliverable/project tag information (0439), and wherein the

database agent is adapted to transfer deliverable/project tag information of the task tag of the

communication to the database.

As concerns claims 1-12, it has been held that the recitation that an element is "adapted

to" perform a function is not a positive limitation but only requires the ability to so perform. It

does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

As concerns claim 13, a method for automatically tracking progress of a task on a

computer network consisting of one or more users on a plurality of computer systems, the

method comprising step of: tagging a communication to be delivered between the computer

systems over the network to form a tagged communication (0090-email); and acting on the

tagged communication automatically by a database agent (0031;0090).

As concerns claim 14, a method as in claim 13 where the tagged communication includes

an electronic mail communication (email) (0090).

As concerns claim 16, a method as in claim 13 where the tagged communication includes

a telephone message converted to electronic communication with the use of voice-recognition

software (0536).

As concerns claim 17, a method as in claim 13 wherein the step of acting involves storing

the task in the database (0090).

As concerns claim 18, a method as in claim 13 where the step of acting involves updating information about the task in the database (0090).

As concerns claim 19, a method as in claim 13 where the step of acting involves generating a report (0408,0409).

As concerns claims 20 and 22, a method as in claim 13 where the users are selected from a group consisting of individuals (users are inherently individuals), collaborators, team leaders and managers.

As concerns claim 21, a method as in claim 13 wherein the users include other computer programs, and wherein the other computer programs produce data including computer usage at a present or remote site (inherent for computer programs to produce data in view of computer usage), manufacturing yield, or customer purchasing patterns.

As concerns claim 23, a method as in claim 13 wherein an importance of the task on the tag is set and negotiated by the users (0294,0318,0322).

As concerns claim 24, a method as in claim 13 wherein a time duration (0398-time intervals) of the task on the tag is set and negotiated by the users.

As concerns claim 25, a method as in claim 13 wherein the step of acting involves merging communications from various tasks into one communication for a single task (0520).

As concerns claim 26, a method as in claim 13 wherein the step of acting involves separating communications from one task into several communications for separate tasks (0519-multiuser database).

As concerns claim 27, a method as in claim 13 wherein the step of acting involves

monitoring a task deadline (0398) and being proactive in sending communication to humans

and computers participating in the task (0318).

As concerns claim 28, a method as in claim 13 wherein tag properties on the

communication include time to task completion, task progress, task topic, reminder interval, and

collaborator type (0398).

As concerns claim 29, a method as in claim 13 wherein choices for tagging the

communication include a tag property of a task progress which selected from a group consisting

of previous, new, in-progress, complete, other (0090-other which can be anything).

As concerns claim 30, a method as in claim 13 wherein choices for tagging the

communication include a tag property of a collaborator type which can be selected from a group

consisting of individual (users tagged), collaborator, team leader, manager, senior manager,

vice-president, CEO, CIO, contractor.

As concerns claim 31, a method as in claim 13 wherein permissions may be associated

with the task restricting viewing of the task only to users with appropriate access credentials

(0357-ID).

As concerns claim 32, a method as in claim 13 wherein the step of tagging a

communication comprises adding deliverable/project information and task information to the

communication (0090-0093).

As concerns claim 33, a system for tracking tasks comprising: a communication system

(network) adapted to attach a task tag to a communication; and a tracking system (0090) separate

from a communication sending computer and a communication receiving computer (fig. 1)

which is adapted to automatically enter predetermined information of the task tag of the

communication into a database (0090). It has been held that the recitation that an element is

"adapted to" perform a function is not a positive limitation but only requires the ability to so

perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ

138.

As concerns claim 34, a method of tracking tasks comprising: sending a communication;

attaching a task tag (0090;0180;0093) to the communication; recording, by an automatic

database agent (0031,0090-program), at least a portion of data in the task tag into a database

(0090); and automatically sending a communication by the automatic database agent based, at

least partially, on the data in the task tag.

As concerns claim 35, a program storage device readable by a machine, tangibly

embodied in a program of instructions executable by the machine to perform method steps for

tracking tasks, the method comprising steps of: searching a first communication to determine if

the first communication has a task tag (0090;0180;0093), the task tag comprising a task topic

and a task progress; and automatically sending a second communication by an automated

database agent (0031,0090-program) based upon data in the task tag.

As concerns claim 36, a program storage device readable by a machine, tangibly

embodied in a program of instructions executable by the machine to perform method steps for

tracking tasks, the method comprising steps of: creating a communication (0090-email); and

attaching a task tag (0090;0180;0093) to the communication comprising a task topic and a task

progress.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. PGPUB

2002/0095454 to Reed in view of U.S. Patent No. 2004/0030741 to Wolton et al.

Reed does not explicitly disclose an instant electronic message (IM).

Wolton et al. teach instant messaging (abstract-last 4 lines).

It would have been obvious to one having ordinary skill in the art at the time of the

invention to provide instant messaging, as taught by Wolton et al., in order to provide a means

of communicating quicker. Such a modification is merely a combination of known elements

providing expected results.

Response to Arguments

7.   Applicant's arguments filed January 4, 2008 have been fully considered but they are not

persuasive.

The applicant argues since the claim is reciting a "database" the claimed invention is

clearly a machine. A database is a collection of data and it does not inherently or automatically

incorporate the properties a physical device. The applicant further argues the claim recites a

"database agent". The applicant argues the agent is incapable of performing the claimed function

unless it is being operated by a machine. The examiner agrees, thus the claim should recite a machine since an "agent" is well known in the art to cover software.

The applicant argues Reed et al. do not disclose a database agent as recited in claim 1. "adapted to" determine if a communication has a task tag, transfer the tag to the database and automatically send a communication based on the tag (p. 11, second paragraph). The claims have been given the broadest reasonable interpretation and Reed et al. discloses the claim limitations at least at (paragraph 0090 and abstract- program, database, information stored in database, metadata, notification methods).

As concerns claim 13, the claims have been given the broadest reasonable interpretation and Reed et al. discloses the claim limitations at least at (paragraph 0031, 0090 and the abstract- program, database, information stored in database, metadata, and notification methods).

As concerns claim 33-36, the claims have been given the broadest reasonable interpretation and Reed et al. discloses the claim limitations at least as recited in the rejection above.

As concerns the "adapted to" clauses, the examiner has not ignored these clauses. The claims have been given the broadest reasonable interpretation and the language of "adapted to" has been taken into consideration since the recited claim elements are "adapted to" perform a function, thus only requiring the ability to so perform. Reed et al. anticipates the claims since it discloses equivalent structure that is "adapted to" perform the function.

Conclusion

8.   In view of the appeal brief filed on December 8, 2008, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth above.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between

the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing

below.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The

examiner can normally be reached on Monday-Thursday from 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/

Primary Examiner, Art Unit 2451

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451